

Appl. No. 09/735,572
Amdt. Dated 02/01/2006
Reply to Office Action of October 1, 2005

REMARKS

This Amendment is in response to the Office Action mailed November 1, 2005. In the Office Action, claims 1-9, 14-22 and 27-30 were rejected under 35 U.S.C. § 103. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Request for Examiner's Interview

The undersigned attorney has been unable to coordinate a telephone conference with the Examiner. In order to facilitate prosecution of the subject application, the Examiner is respectfully requested to contact the undersigned by telephone if, after review, such claims are still not in condition for allowance. The undersigned attorney can be reached at the telephone number listed below.

Rejections Under 35 U.S.C. §103

I. CLAIMS 1-4, 8-9 AND 27-30

Claims 1-4, 8-9 and 27-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sako in view of Wang (U.S. Patent No. 5,802,361). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See MPEP §2143; see also In Re Fine, 873 F. 2d 1071, 5 U.S.P.Q.2D 1596 (Fed. Cir. 1988)*. Herein, the combined teachings of the cited references fail to describe or suggest all the claim limitations.

For instance, with respect to claims 1 and 27, Applicants respectfully submit that neither Sako nor Wang, alone or in combination, describes or suggests an operation and/or software for *suggesting a color for subsequent user selection based on the generated histogram to serve as the color for a template design used to display the source image*. *Emphasis added*. In fact, nowhere in the cited passages of these references is there any discussion of color selection by the user for a "template design" for the source image being based on a generated histogram.

On page 3 of the Office Action, the Examiner states that Sako fails to teach the operation of suggesting a color for subsequent user selection based on a generated histogram, by displaying at least one color for the template design. Applicants agree. However, the Office Action states that Wang teaches suggesting a color for subsequent user selection by displaying at least one color for the template design. *See col. 11, lines 32-59; col. 12, lines 36-62 and col. 15, line 52 to col. 16, line 3 of Wang*. Applicants respectfully disagree with this statement because Wang is directed to a mechanism for searching graphic images, and does not describe or suggest any operations or software for suggesting color for a template design as claimed.

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For Wang, a color histogram for each image is contained within a color histogram side information file, which may be analyzed (low level analysis) to extract various statistical abstractions from each image that can be related to semantically meaningful abstractions that a user may use to describe the image. Wang describes an example of searching for a "blue sky" and enabling the user to locate images with a blue sky. See col. 17, lines 35-52 of Wang.

In contrast, the claimed invention is directed *suggesting a color* for subsequent user selection based on the generated histogram *to serve as the color for a template design used to display the source image*. *Emphasis added*. The search system of Wang is adapted for search purposes, and is not configured to provide any suggestion of template design colors, even when combined with the teachings of Sako. Rather, search system of Wang provides a mechanism searching for graphic images based on semantically meaningful abstractions including those abstractions mentioning particular colors as noted above.

Hence, withdrawal of the §103(a) rejection as applied to independent claims 1 and 27 is respectfully requested.

In addition, based on the dependency of claims 2-4, 8-9 and 28-30 on independent claims 1 and 27, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Withdrawal of the §103(a) rejection as applied to claims 2-4, 8-9 and 28-30 is respectfully requested.

II. CLAIM 5

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako in view of Takayama (U.S. Patent No. 6,222,570). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. First, Sako does not teach the limitation of "suggesting a color for subsequent user selection based on the generated histogram to serve as the color for a template design..." as set forth in claim 1. In fact, the Examiner agreed with this lack of teaching as stated on page 3 of the Office Action. Moreover, upon review, Takayama does not provide such teachings as well, and if so, respectfully requests the Examiner to identify such teachings. Applicants respectfully submit that *prima facie* case of obviousness has not been established because the limitations of claim 7 are not described or suggested by the combined teachings of Sako and Takayama.

Applicants respectfully submit that the combined teachings of Sako and Takayama fail to describe or suggest an operation for suggesting color of a template design for subsequent user selection based on the generated histogram as claimed. Takayama teaches an operation of providing a static template image (57) having a color that is not based on a generated histogram for the source image as claimed in independent claim 1. Hence, withdrawal of the §103(a) rejection as applied to claim 5 is respectfully requested.

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III. CLAIM 7

Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako in view of Sparks (U.S. Patent No. 6,167,382). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. First, Sako does not teach the limitation of "suggesting a color for subsequent user selection based on the generated histogram to serve as the color for a template design..." as set forth in claim 1. The Examiner states this fact on page 3 of the Office Action. Moreover, upon review, Sparks does not provide such teachings, and if the Examiner disagrees with this statement, Applicants respectfully request the Examiner to identify such teachings. Applicants respectfully submit that *prima facie* case of obviousness has not been established because the limitations of claim 7 are not described or suggested by the combined teachings of Sako and Sparks.

Moreover, Sparks teaches generation of a menu templates that identifies prices of selected items. However, in contrast to the claimed invention, neither Sako nor Sparks, alone or in combination, teaches an operation of receiving *compensation for providing the color template design*. *Emphasis added*. Hence, withdrawal of the §103(a) rejection as applied to claim 7 is respectfully requested.

IV. CLAIMS 14-15 AND 17

Claims 14-15 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako in view of Tushie (U.S. Patent No. 6,202,155). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. With respect to the rejection of claim 14, it is noted that the Office Action states Sako teaches "suggesting a color based on the generated histogram to serve as the color for a template design used to display (4) the source image." See Page 6 of the Office Action. However, page 3 of the Office Action states that "Sako fails to teach suggesting a color for subsequent user selected based on a generated histogram...." Applicants believe that these statements contradict each other and respectfully request the Examiner to reconsider, and if need be, reissue a new Office Action for clarification purposes.

Moreover, the Office Action further states that the source image is equivalent to the input image derived from the camera. See Page 6 of the Office Action. As such, the ratio histogram is generated for colors associated with the source image, and not the template design as set forth in claim 14. Hence, a *prima facie* case of obviousness cannot be maintained. Withdrawal of the §103(a) rejection as applied to independent claim 14 is respectfully requested.

V. CLAIMS 16 AND 21-22

There is no indication in the Office Action of any rejection applied to claims 16 and 21-22. Applicants respectfully request the Examiner to provide an explanation of the status of these claims in a subsequent Office Action, if needed. Based on the dependency of claims 16 and 21-22 on independent claim 14, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse should be warranted.

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VI. CLAIMS 18 AND 20

Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako and Tushie and Takayama. In addition, Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako and Tushie in view of Sparks. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. Based on the dependency of claims 18 and 20 on independent claim 14, believed by Applicants to be in condition for allowance, no further discussion as to the grounds for traverse is warranted. Withdrawal of the §103(a) rejection as applied to claims 18 and 20 is respectfully requested.

VII. CLAIMS 6 AND 19

Claims 6 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sako in view of Jammes (U.S. Published Application No. 2003/0167213). Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established. With respect to claim 6, Sako does not teach the limitation of "suggesting a color for subsequent user selection based on the generated histogram to serve as the color for a template design..." as set forth in claim 1. In fact, the Examiner agreed with this contention as stated on page 3 of the Office Action. Moreover, upon review, Jammes does not provide such teachings as well, and if so, respectfully requests the Examiner to identify such teachings. Applicants respectfully submit that *prima facie* case of obviousness has not been established because the limitations of claim 6 are not described or suggested by the combined teachings of Sako and Jammes.

Moreover, based on the dependency of claims 6 and 19 on independent claims 1 and 14, believed by Applicants to be in condition for allowance as noted above, no further discussion as to the grounds for traverse is warranted. Withdrawal of the §103(a) rejection as applied to claims 6 and 19 is respectfully requested.

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Conclusion

Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: February 1, 2006

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